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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054551
Party	Defendant Douglas Burda
Correspondence Address	DOUGLAS BURDA KONCEPT LLC 900 LAS VEGAS BOULEVARD SOUTH, UNIT 1009 LAS VEGAS, NV 89101 UNITED STATES dbb@konceptlaw.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Douglas Burda
Filer's e-mail	dbb@konceptlaw.com
Signature	/Douglas Burda/
Date	12/07/2011
Attachments	Motion For Leave to File Second Amended Answer.pdf (8 pages)(55452 bytes) Exhibit 1 Cover Sheet and Second Amended Answer.pdf (9 pages)(254635 bytes) Certificates.pdf (1 page)(27873 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ANDREY PINSKY

Petitioner,

v.

Cancellation No. 92054551

DOUGLAS BURDA

Respondent.

**REGISTRANT’S MOTION FOR LEAVE TO FILE SECOND AMENDED ANSWER AND
AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION**

Respondent, Douglas Burda (Registrant) hereby moves the Trademark Trial and Appeal Board (Board) for leave to allow Registrant to file REGISTRANT’S SECOND AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION (Second Amended Answer) in the above-referenced proceeding.

Registrant’s motion (Motion) is supported by Registrant’s BRIEF IN SUPPORT OF MOTION, below, the [Proposed] REGISTRANT’S SECOND AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION, attached hereto as Exhibit 1, the papers on file with the Board in this matter, and any other matters properly before the Board.

BRIEF IN SUPPORT OF MOTION

I. BACKGROUND.

On October 31, 2011 Registrant filed its answer in this matter, and then on November 14, 2011, Registrant filed its amended answer. On November 29, 2011, the Board participated in the discovery conference between Petitioner and Registrant. During the discovery conference, Registrant brought up to the Board Registrant's affirmative defense that "Petitioner lacks standing to practice before the United States Patent and Trademark Office." See Registrant's First Amended Answer and Affirmative Defenses to Petition for Cancellation (First Amended Answer), ¶14 (the Use Defense). The Board *sua sponte* struck the Use Defense, and in so doing, the Board modified the Registrant's First Amended Answer on the basis that no construction of the Use Defense would warrant Registrant's intended meaning of same. On December 1, 2011, the Board issued its Discovery Conference Summary Order confirming the Board's *sua sponte* action regarding the Use Defense. Registrant received the Board's Discovery Conference Summary Order on December 5, 2011 and contacted Petitioner telephonically on December 6, 2011 to seek Petitioner's written consent to file a Second Amended Answer in response thereto. Petitioner refused to provide such written consent and Registrant filed this Motion on December 7, 2011.

II. LEGAL STANDARD.

The policy of granting leave to amend is a liberal one, and should ordinarily be granted whenever doing so will not unduly delay trial or prejudice the other party. *Microsoft Corp. V. Quantel Business Systems, Inc.*, 16 USPQ2d 1732, 1733 (TTAB 1990). Likewise, FRCP 15(a) reflects an underlying policy that disputes should be

determined on their merits, not on the technicalities of pleading rules, and that leave sought, as the rules require, should be “freely given”. *Foman v. Davis*, 371 U.S. 178, 181-182 (1962).

Additionally, the Board has firmly established that “amendments to pleadings should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that the entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.” *American Optical Corp. V. American Olean Tile Co., Inc.*, 168 USPQ 471, 473 (TTAB 1970).

There are typically four factors that are relevant to determining whether leave should be granted: (1) whether there has been undue delay; (2) whether the moving party has acted in bad faith or with a “dilatory motive”; (3) whether the amendment would be futile because the claims appear on their face to be frivolous; and (4) whether the non-moving party would be prejudiced by granting leave to amend. *Foman* at 182.

As set forth herein, each of the four factors weigh in favor of granting the leave sought by Registrant.

III. ARGUMENT.

A. Amendment Will Not Prejudice Petitioner.

Petitioner could not possibly be prejudiced by Registrant’s amendment because the issue addressed by Registrant’s amendment, namely the Use Defense, is not a new one. In fact, Registrant included the Use Defense in its original answer. Additionally, Registrant brought this issue up to the Board during the Discovery Conference where the Board found the Use Defense impermissible as to form only, and struck it *sua*

sponte on the basis of such defect. Thus, the purpose of Registrant's Second Amended Answer, as discussed herein, is merely to correct that defect that the Board indicated during the discovery conference, namely that no construction of the Use Defense would warrant the reading Registrant intended thereby.

While Registrant's amendment would not force Petitioner to confront any new issues, denying Registrant leave would prejudice Registrant. For example, Registrant may lose its ability to challenge certain aspects of Petitioner's claims, including at least one such aspect that may be dispositive to this matter.

Leave to amend is typically granted even more liberally when the proceeding is still in the discovery stage because this circumstance lessens any potential prejudice that an amendment might otherwise bring. *Microsoft* at 1733-34 (finding that undue prejudice will not result from amendment while the proceeding remains in discovery stage.) Here, Registrant's amendment will not prejudice Petitioner in any regard because this matter is in its very early stages. Indeed, the discovery conference was concluded just over one (1) week before the date of this filing, neither party has served its initial disclosures, and this Motion is the first true motion in this matter. Discovery has only been open for five (5) days, since December 2, 2011, and notably, as explained more fully herein, Registrant acted with swiftness in filing this Motion when the ground for same became objectively apparent.

As such, because Petitioner will not experience any prejudice by entry of Registrant's amendment, this factor weighs in favor of granting Registrant's Motion.

B. Registrant Acted Swiftly.

Registrant has acted swiftly in seeking leave to file the Second Amended Answer, and the Board should grant the Registrant's Motion as this Board has firmly established that the timing associated with a motion for leave to amend a pleading is of paramount significance in determining whether a party would be prejudiced by the entry that amendment. See *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (*motion to amend permitted when Movant filed prior to opening of petitioner's testimony*); *Microsoft Corp.*, 16 USPQ2d 1732 (*movant acted quickly since proceeding still in discovery period*). Indeed, the Board's Order, to which this Motion is responsive, was issued on December 2, 2011, mailed to Registrant the same day, and received by Registrant on December 5, 2011. On December 6, 2011, Registrant contacted Petitioner to seek Petitioner's written consent to file Registrant's Second Amended Answer in lieu of having to file this Motion. When Petitioner baselessly refused Registrant's request on December 7, 2011, Registrant immediately filed this Motion and thus, acted with the necessary measure of haste in doing so, with the object of expediently addressing this matter.

Further, this Board has established that a motion like Registrant's Motion must be filed when the impetus for such a filing becomes apparent. *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008). "A motion for leave to amend should be filed as soon as any ground for such amendment [] becomes apparent. *Id.* In this case, Registrant immediately filed the instant Motion when the grounds for same were provided for in the Board's Discovery Conference Summary Order. The only delay between issuance of the Board's Discovery Conference Summary Order and the filing

of this Motion is due squarely to the delay between the time that Registrant sought Petitioner's written consent to file the Second Amended Answer in lieu of this Motion, and the time that Petitioner took to ultimately deny Registrant's request. Thus, Registrant filed Registrant's Motion when the time was ripe and other reasonable options had been exhausted.

Moreover, even if undue delay is somehow imparted to Registrant, the Board can mitigate any prejudice that may result therefrom by enlarging the discovery period pursuant to, for example, Petitioner's motion for same, which Registrant would consent to. *Microsoft*, 16 USPQ2d at 1733-34.

As such, because Registrant acted swiftly and timely in seeking leave to amend via this Motion, this factor also weighs in favor of granting Registrant's Motion.

C. Amendment Will Not Be Futile.

The amendment that Registrant seeks in this instance will by no means be futile in any regard. It is established that "[i]f the underlying facts or circumstances relied upon by a [party] may be a proper subject of relief, he ought to be afforded an opportunity to test his claim on the merits." *Foman*, 371 U.S. at 182. Here, the Second Amended Answer, being responsive to the Board's Order (as discussed herein), seeks to clarify a basis that Registrant may assert as a ground for filing a dispositive motion, namely, the Use Defense. Thus, even if the purpose of Registrant's Motion were less impactful, reason would still exist to grant Registrant's Motion because the affirmative defense that Registrant seeks to clarify is well-established by the trademark laws and the case law interpreting such laws, and most significantly, supported by undisputed facts in this matter.

Moreover, even if Registrant's proposed amendment was not filed with the purpose of correcting a defect previously cited by this Board, as it presently is, this Board may still grant Registrant's Motion since, at minimum, the Second Amended Answer "may serve simply to amplify allegations already included in the [Registrant's] pleading." TBMP § 507.02. which in this case, Registrant asserts that it does, at minimum.

As such, because Registrant's amendment will not be futile by any means, this factor also weighs in favor of granting Registrant's Motion.

D. Registrant Acted In Good Faith and With No Dilatory Motive.

Registrant has acted only in good faith and with no dilatory motive, not only with respect to this issue specifically, but throughout the short duration of this matter in general. As mentioned, Registrant's Motion is sought only for the purpose of correcting a form-based defect in the First Amended Answer, and even then only because of a single affirmative defense that the Board determined during the discovery conference did not allow for the construction that Registrant intended thereby. In fact, Registrant's amendment, if granted, will likely have the effect of accelerating the resolution of this matter.

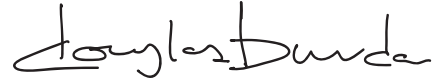
As such, because Registrant acted in good faith and Registrant's amendment will serve to facilitate resolution of this case, this factor also weighs in favor of granting Registrant's Motion.

IV. CONCLUSION.

For all of the forgoing reasons, Registrant respectfully requests that the Board grant Registrant's Motion and accept and enter the Second Amended Answer.

December 7, 2011

Respectfully submitted,

A handwritten signature in black ink that reads "Douglas Burda". The signature is written in a cursive, flowing style.

Douglas Burda
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Attorney & Registrant

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ANDREY PINSKY

Petitioner,

v.

Cancellation No. 92054551

DOUGLAS BURDA

Respondent.

**REGISTRANT'S EXHIBIT 1 TO REGISTRANT'S MOTION FOR LEAVE TO FILE
SECOND AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO
PETITION FOR CANCELLATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ANDREY PINSKY

Petitioner,

v.

Cancellation No. 92054551

DOUGLAS BURDA

Respondent.

**SECOND AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO
PETITION FOR CANCELLATION**

Respondent, Douglas Burda (Registrant), an individual having an address of 900 Las Vegas Boulevard South, Unit 1009 in Las Vegas, Nevada 89101, believing it is rightfully and lawfully entitled to the continued use of the trademark delineated in United States Trademark Registration No. 3981394 on the Principal Register, hereby responds to Andrey Pinsky's (Petitioner's) Petition For Cancellation (Petition) as follows:

Any paragraph of the Petition stating a conclusion of law does not require Registrant's response, but to the extent that such a response is required, it is provided below.

The unnumbered paragraphs before numbered paragraph 1 in the Petition do not call for a response. Notwithstanding the foregoing, Registrant is without knowledge or information sufficient to form a belief as to the truth of the averment that Petitioner is, in fact, a Canadian lawyer.

1. Registrant denies the allegations of this averment.

2. Registrant admits that Registrant is an attorney licensed to practice in the State of Nevada in the United States, and that Registrant is the owner of United States Trademark Registration No. 3981394. Registrant denies the remaining allegations of this averment.
3. Registrant admits the allegations of this averment.
4. Registrant admits that Congress may regulate the sale, advertising, and promotion of legal services. Registrant denies the remaining allegations of this averment.
5. Registrant denies the allegations of this averment.
6. Registrant denies the allegations of this averment.
7. Registrant admits that Registrant uses and has obtained a federal registration for Registrant's mark (the Mark) (See the issued Certificate of Registration of the Mark, and a current printout of information from the Office's electronic database records showing the current status and title of the registration for same, attached hereto as Exhibit 1). Registrant denies the remaining allegations of this averment.
8. Registrant admits that Registrant uses and has obtained a federal registration for the Mark (See Exhibit 1). Registrant denies the remaining allegations of this averment.
9. Registrant admits that Registrant is engaged in the offering of legal services. Registrant denies the remaining allegations of this averment.
10. Registrant denies the allegations of this averment.
11. Registrant admits that Registrant uses and has obtained a federal registration for the Mark (See Exhibit 1). Registrant denies the remaining allegations of this averment.

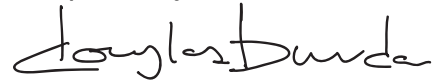
AFFIRMATIVE DEFENSES

Without waiver of its Amended Answer, Registrant asserts the following affirmative defenses to the Petition:

- 12.** Petitioner fails to state a cognizable basis upon which relief can be granted as Petitioner's alleged use of Petitioner's alleged mark, even if proven, could not establish that Petitioner has or ever had superior rights to that of Registrant's.
- 13.** Petitioner has knowingly and with intent to deceive made misrepresentations to Registrant, to the public, and before the United States Patent and Trademark Office (USPTO), which were relied upon by each respective recipient of such misrepresentations to their respective detriments, and such misrepresentations warrant denial of the Petition.
- 14.** Petitioner lacks standing to practice before the United States Patent and Trademark Office in this matter because Petitioner, has failed to demonstrate that Petitioner lawfully uses Petitioner's alleged mark in commerce between the United States and Canada and thus has no real interest in the proceedings and no basis for any belief of damage. Such circumstances warrant denial of the Petition.
- 15.** Petitioner has unclean hands that warrant denial of the Petition.
- 16.** Petitioner's claims are barred by the doctrine of laches.
- 17.** Petitioner's claims are barred because there is no likelihood of confusion.
- 18.** Registrant is at least entitled to registration with a restriction that Registrant is not using the Mark for provision of newsletters in the field of Canadian legal news. Such restriction will avoid any likelihood of confusion as Registrant is not using the Mark for provision of such services.

December 7, 2011

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Douglas Burda". The signature is fluid and cursive, with the first name "Douglas" written in a larger, more prominent script than the last name "Burda".

Douglas Burda
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EXHIBIT 1

United States of America
United States Patent and Trademark Office

KONCEPT

Reg. No. 3,981,394

Registered June 21, 2011

Int. Cl.: 45

SERVICE MARK

PRINCIPAL REGISTER

BURDA, DOUGLAS (UNITED STATES INDIVIDUAL)
P.O. BOX 15533
LAS VEGAS, NV 89114

FOR: LEGAL SERVICES, IN CLASS 45 (U.S. CLS. 100 AND 101).

FIRST USE 6-12-2010; IN COMMERCE 6-12-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-176,628, FILED 11-15-2010.

CARYN GLASSER, EXAMINING ATTORNEY



David J. Kypos

Director of the United States Patent and Trademark Office

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2011-11-14 14:55:55 ET

Serial Number: 85176628 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3981394

Mark

KONCEPT

(words only): [KONCEPT](#)

Standard Character claim: [Yes](#)

Current Status: A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Date of Status: 2011-09-23

Filing Date: 2010-11-15

Filed as TEAS Plus Application: [Yes](#)

Currently TEAS Plus Application: [Yes](#)

Transformed into a National Application: [No](#)

Registration Date: 2011-06-21

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 108](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2011-06-21

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [Burda, Douglas](#)

Address:

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[900 Las Vegas Boulevard South, Unit 1009](#)
[Las Vegas, NV 89101](#)
[United States](#)

Legal Entity Type: [Individual](#)

Country of Citizenship: [United States](#)

Phone Number: [\(248\) 217-0002](#)

GOODS AND/OR SERVICES

International Class: [045](#)

Class Status: [Active](#)

[Legal services](#)

Basis: [1\(a\)](#)

First Use Date: [2010-06-12](#)

First Use in Commerce Date: [2010-06-12](#)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

[2011-09-25 - TEAS Change Of Correspondence Received](#)

[2011-09-23 - Cancellation Instituted No. 999999](#)

[2011-09-22 - Applicant/Correspondence Changes \(Non-Responsive\) Entered](#)

[2011-09-22 - TEAS Change Of Owner Address Received](#)

2011-06-21 - Registered - Principal Register
2011-06-16 - FAX RECEIVED
2011-04-05 - Notice Of Actual Publication E-Mailed
2011-04-05 - Published for opposition
2011-02-24 - Approved for Pub - Principal Register (Initial exam)
2011-02-24 - Assigned To Examiner
2010-11-19 - Notice Of Pseudo Mark Mailed
2010-11-18 - New Application Office Supplied Data Entered In Tram
2010-11-18 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Douglas Burda

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Phone Number: (248) 217-0002

CERTIFICATE OF ELECTRONIC FILING

I certify that a true and complete copy of the foregoing REGISTRANT'S MOTION FOR LEAVE TO FILE SECOND AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION is being electronically transmitted to the Trademark Trial and Appeal Board, U.S. Patent and Trademark Office on December 7, 2011.

By: 
Douglas Burda

CERTIFICATE OF SERVICE

I certify that a true and complete copy of the foregoing REGISTRANT'S MOTION FOR LEAVE TO FILE SECOND AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION has been served on Andrey Pinsky by mailing said copy on December 7, 2011, via First Class Mail International, postage prepaid to:

ANDREY PINSKY
PINSKY LAW
45 SHEPPARD AVE EAST SUITE 900
TORONTO, ON M2N 5W9
CANADA

By: 
Douglas Burda